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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,714	05/16/2001	Kazuaki Ebara	31869-171865	9422
26694	7590	10/06/2005	EXAMINER	
VENABLE LLP			HOFFMAN, BRANDON S	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	
			2136	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/855,714	EBARA, KAZUAKI	
	Examiner	Art Unit	
	Brandon S. Hoffman	2136	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-19 are pending in this office action.
2. Applicant's arguments, filed August 1, 2005, have been considered but they are not persuasive.

### ***Rejections***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoka (U.S. Patent No. 6,591,249) in view of Johnson (U.S. Patent No. 6,529,885).

Regarding claim 1, Zoka teaches a biometric authentication system comprising a first enterprise system, a second enterprise system, and a communication network interconnecting the first enterprise system and the second enterprise system (fig. 5, ref. num 24, 30, and 48), wherein:

The first enterprise system includes:

- A registration apparatus for acquiring a user's biometric information in advance of authentication, extracting features therefrom, and converting the features to template data (fig. 3),

- A first authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 2, ref. num 16), and
- A first database server apparatus for receiving the template data from the registration apparatus, storing and managing the template data, receiving the authentication data from the first authentication apparatus during authentication, comparing the authentication data with the template data, thereby authenticating the user (fig. 6 and 7); and

The second enterprise system includes:

- A second authentication apparatus for acquiring the user's biometric information, extracting features therefrom, and converting the features to authentication data (fig. 5 and col. 8, line 61 through col. 9, line 3).

Zoka does not teach a second database server apparatus for receiving the authentication data from the second authentication apparatus, requesting corresponding template data from the first database server apparatus, receiving the corresponding template data from the first database server apparatus, comparing the authentication data with the corresponding template data, thereby authenticating the user, and storing and managing the received template data if the user is authenticated successfully.

Johnson teaches a second database server apparatus for receiving the authentication data from the second authentication apparatus, requesting corresponding

template data from the first database server apparatus, receiving the corresponding template data from the first database server apparatus, comparing the authentication data with the corresponding template data, thereby authenticating the user, and storing and managing the received template data if the user is authenticated successfully (fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the second database server apparatus receiving authentication data from the second apparatus, requesting template data from the first apparatus, comparing the received data with the generated data, and storing the received template data, as taught by Johnson, with the system of Zoka. It would have been obvious for such modifications because storing initial authentication information at a source that a user trusts (the web buyer's home bank) provides user trust in online systems. Also, only allowing non-critical data to be supplied to the web seller helps prevent critical data (passwords, account information) from being transmitted across open networks (see col. 14, lines 20-64 of Johnson).

Regarding claim 2, Zoka as modified by Johnson teaches wherein the second database server apparatus sends the authentication data received from the second authentication apparatus to the first database server apparatus, and the first database server apparatus includes a one-to-many biometric identification unit that performs a one-to-many comparison between the authentication data received from the second

database server apparatus and all of the template data stored and managed by the first database server apparatus to find the template data corresponding to the authentication data (see col. 9, lines 3-19 of Zoka).

Regarding claims 3, 6, and 10, Zoka as modified by Johnson teaches wherein the first database server apparatus includes a billing unit that charges the second enterprise system a fee when the second database server apparatus requests corresponding template data and the first database server apparatus sends the corresponding template data and personal information to the second database server apparatus (see col. 13, lines 50-52 of Johnson).

Regarding claim 4, Zoka as modified by Johnson teaches wherein the second database server apparatus sends the authentication data received from the second authentication apparatus to the first database server apparatus when requesting the corresponding template data, and the first database server apparatus includes a one-to-many biometric identification unit that performs a one-to-many comparison between the authentication data received from the second database server apparatus and all of the template data stored and managed by the first database server apparatus to find the template data corresponding to the authentication data (see col. 9, lines 3-19 of Zoka).

Regarding claim 5, Zoka as modified by Johnson teaches wherein:

- The first database server apparatus includes a first personal-information database storing personal information about the user (see col. 5, lines 40-46 of Zoka);
- When the first database server apparatus sends the corresponding template data to the second database server apparatus, the first database server apparatus also sends the personal information about the user to the second database server apparatus (see col. 9, lines 11-19 of Zoka); and
- The second database server apparatus includes a second personal-information database that stores and manages the personal information about the user received from the first database server apparatus (see col. 14, lines 5-19 of Johnson).

Regarding claim 7, Zoka teaches a biometric authentication system comprising a first enterprise system, a second enterprise system, and a communication network interconnecting the first enterprise system and the second enterprise system (fig. 5, ref. num 24, 30, and 48), wherein:

The first enterprise system includes:

- A registration apparatus for acquiring a user's biometric information in advance of authentication, extracting features therefrom, and converting the features to template data (fig. 3),

- A first authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 2, ref. num 16), and
- A first database server apparatus for receiving the template data from the registration apparatus, storing and managing the template data, receiving the authentication data from the first authentication apparatus during authentication, comparing the authentication data with the template data, thereby authenticating the user, receiving authentication data from the second enterprise system, and returning corresponding template data to the second enterprise system if the corresponding template data is stored in the first database server apparatus (fig. 6 and 7 and col. 9, lines 3-19); and

The second enterprise system includes:

- A simplified registration apparatus for acquiring the user's biometric information during registration, extracting features therefrom, and converting the features to authentication data (col. 1, lines 7-16),
- A second authentication apparatus for acquiring the user's biometric information during authentication, extracting features therefrom, and converting the features to authentication data (fig. 5 and col. 8, line 61 through col. 9, line 3).

Zoka does not teach a second database server apparatus for receiving the authentication data from the simplified registration apparatus and the second authentication apparatus, sending the authentication data received from the simplified



registration apparatus to the first database server apparatus, receiving the corresponding template data from the first database server apparatus, storing and managing the received template data, and comparing the authentication data received from the second authentication apparatus with the stored template data, thereby authenticating the user.

Johnson teaches a second database server apparatus for receiving the authentication data from the simplified registration apparatus and the second authentication apparatus, sending the authentication data received from the simplified registration apparatus to the first database server apparatus, receiving the corresponding template data from the first database server apparatus, storing and managing the received template data, and comparing the authentication data received from the second authentication apparatus with the stored template data, thereby authenticating the user (fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the second database server apparatus receiving authentication data from the second apparatus, requesting template data from the first apparatus, comparing the received data with the generated data, and storing the received template data, as taught by Johnson, with the system of Zoka. It would have been obvious for such modifications because storing initial authentication information at

a source that a user trusts (the web buyer's home bank) provides user trust in online systems. Also, only allowing non-critical data to be supplied to the web seller helps prevent critical data (passwords, account information) from being transmitted across open networks (see col. 14, lines 20-64 of Johnson).

Regarding claim 8, Zoka teaches a database server apparatus for use in a first enterprise system that is linked by a communication network to a second enterprise system (fig. 5, ref. num 24, 30, and 48), for receiving biometric template data and biometric authentication data from the first enterprise system, storing and managing the biometric template data (fig. 6 and 7), comparing the biometric authentication data with the biometric template data, thereby authenticating users of the first enterprise system.

Zoka does not teach supplying the biometric template data on request to the second enterprise system to enable users of the first enterprise system to become registered with the second enterprise system.

Johnson teaches supplying the biometric template data on request to the second enterprise system to enable users of the first enterprise system to become registered with the second enterprise system (fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine supplying template data to the second apparatus upon request to enable users of the first apparatus to become registered with the second apparatus, as taught by Johnson, with the apparatus of Zoka. It would have been obvious for such modifications because storing initial authentication information at a source that a user trusts (the web buyer's home bank) provides user trust in online systems. Also, only allowing non-critical data to be supplied to the web seller helps prevent critical data (passwords, account information) from being transmitted across open networks (see col. 14, lines 20-64 of Johnson).

Regarding claim 9, Zoka as modified by Johnson teaches comprising a one-to-many biometric identification unit that performs a one-to-many comparison between biometric authentication data received from the second enterprise system and the biometric template stored and managed by the first database server apparatus to find the biometric template data requested by the second enterprise system (see col. 9, lines 3-19 of Zoka).

Regarding claim 11, Zoka as modified by Johnson teaches comprising a personal-information database storing personal information about the users of the first enterprise system, the personal information being sent to the second enterprise system together with the biometric template data requested by the second enterprise system (see col. 5, lines 40-46 of Zoka).

Regarding claim 12, Zoka as modified by Johnson teaches wherein the database server apparatus receives biometric authentication data from the second enterprise system, compares the received biometric authentication data with the requested biometric template data, and sends the requested biometric template data to the second enterprise system only if the received biometric authentication data match the requested biometric template data (see fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19 of Johnson).

Regarding claim 13, Zoka teaches a database server apparatus for use in a second enterprise system that is linked by a communication network to a first enterprise system (fig. 5, ref. num 24, 30, and 48), for receiving biometric authentication data from the second enterprise system (col. 1, lines 7-16).

Zoka does not teach requesting corresponding biometric template data from the first enterprise system, receiving the requested biometric template data from the first enterprise system, storing and managing the received biometric template data, and comparing the biometric authentication data with the stored biometric template data, thereby authenticating users of the second enterprise system.

Johnson teaches requesting corresponding biometric template data from the first enterprise system, receiving the requested biometric template data from the first enterprise system, storing and managing the received biometric template data, and

comparing the biometric authentication data with the stored biometric template data, thereby authenticating users of the second enterprise system (fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine requesting template data from the first apparatus, storing the received template data, and comparing the received template data with the produced data for authenticating the user, as taught by Johnson, with the apparatus of Zoka. It would have been obvious for such modifications because storing initial authentication information at a source that a user trusts (the web buyer's home bank) provides user trust in online systems. Also, only allowing non-critical data to be supplied to the web seller helps prevent critical data (passwords, account information) from being transmitted across open networks (see col. 14, lines 20-64 of Johnson).

Regarding claim 14, Zoka as modified by Johnson teaches wherein the database server apparatus sends the biometric authentication data received from the second enterprise system to the first enterprise system when requesting the corresponding biometric template data from the first enterprise system (see col. 12, lines 42-56 of Johnson).

Regarding claim 15, Zoka as modified by Johnson teaches comprising a personal-information database for storing personal information about the users of the

second enterprise system, the personal information being received from the first enterprise system together with the requested biometric template data (see col. 9, lines 11-19 of Zoka).

Regarding claims 16-19, Zoka as modified by Johnson teaches wherein the first enterprise system receives the user's biometric information from the second enterprise system, uses the user's biometric information to retrieve the template data, and sends the retrieved template data to the second information system; and wherein the second enterprise information system performs authentication using the retrieved template data sent by the first enterprise system (see fig. 2, col. 6, lines 31-49, and col. 12, line 27 through col. 14, line 19 of Johnson).

### ***Response to Arguments***

5. Applicant argues:
  - a. The combination of Zoka and Johnson does not teach requesting template data, comparing template data, and storing template data (page 10 through page 14, second paragraph, page 14, last paragraph through page 16, first paragraph).
  - b. The dependent claims are allowable based on their dependency (page 14, third paragraph, page 15, second paragraph, and page 16, last paragraph).

Regarding argument (a), examiner disagrees with applicant. Zoka discloses (col. 1, lines 17-28, col. 8, lines 43-49, fig. 3, figure 7, step 80 and col. 9, lines 20-43) storing fingerprint templates during a registration of the user. The stored templates can later be used to verify a biometric input of the user. Johnson, when combined with the stored templates of Zoka, teaches requesting, comparing, and storing template data. Zoka clearly points out the use of storing template data for the use of verifying a user for later transactions. When combined with Johnson, who teaches a encrypted identifier stored by the bank (abstract), will disclose the claimed limitations. Figure 1A of Johnson shows the home bank storing the encrypted ID and figure 1B of Johnson shows the home bank comparing the encrypted, stored ID with a supplied ID. The fact that the home bank compares the stored ID with the supplied ID implies that the ID had to be requested initially. The modifications of stored encrypted ID information (from Johnson) with the stored, encrypted biometric template data (from Zoka) clearly discloses applicants claimed invention.

Regarding argument (a), examiner disagrees with applicant. Based on the response for argument (a) above, the dependent claims stand as rejected.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Brandon S. Hoffman*

BH

*Ayaz R. Sheikh*  
**AYAZ SHEIKH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**